

M \$
cc

**PETITION TO ACCEPT UNAVOIDABLY DELAYED PAYMENT OF
MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(b))**

Docket Number (Optional)
CSI001

#21

RECEIVED

Mail to: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450
Fax: (571) 273-8300

NOV 08 2010

11/05/2010 DALLEN 00000021 6793224

01 FC:1599

1190.00 OP

OFFICE OF PETITIONS

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

Patent Number: 6,793,224

Application Number: 09/801,536

Issue Date: 09-21-2004

Filing Date: 03-08-2001

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number (or reissue patent number, if a reissue) and (2) the application number of the actual U.S. application (or reissue application) leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

Also complete the following information, if applicable:

The above-identified patent:

☐ is a reissue of original Patent No. _____ original issue date _____
original application number _____
original filing date _____

☐ resulted from the entry into the U.S. under 35 U.S.C. 371 of international application
_____ filed on _____

CERTIFICATE OF MAILING OR TRANSMISSION (37 CFR 1.8(a))

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is

(1) being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 OR

(2) transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

October 27, 2010

Date

/Cary Tope-McKay/

Signature

CARY TOPE-MCKAY

Typed or printed name of person signing Certificate

[Page 1 of 4]

This collection of information is required by 37 CFR 1.378(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 8 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

1. SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27

2. LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

3. MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition, unless it was paid earlier.

NOT Small Entity			Small Entity		
Amount	Fee	(Code)	Amount	Fee	(Code)
<input checked="" type="checkbox"/> \$ _____	3 ½ yr fee	(1551)	<input checked="" type="checkbox"/> \$ 490.00	3 ½ yr fee	(2551)
<input type="checkbox"/> \$ _____	7 ½ yr fee	(1552)	<input type="checkbox"/> \$ _____	7 ½ yr fee	(2552)
<input type="checkbox"/> \$ _____	11 ½ yr fee	(1553)	<input type="checkbox"/> \$ _____	11 ½ yr fee	(2553)

MAINTENANCE FEE BEING SUBMITTED \$ _____

4. SURCHARGE

The surcharge required by 37 CFR 1.20(i)(1) of \$ 700.00 (Fee Code 1557) must be paid as a condition of accepting unavoidably delayed payment of the maintenance fee.SURCHARGE FEE BEING SUBMITTED \$ 700.00

5. MANNER OF PAYMENT

- ☐ Enclosed is a check for the sum of \$ _____
- ☐ Please charge Deposit Account No. _____ the sum of \$ _____
- ☒ Payment by credit card. Form PTO-2038 is attached.

6. AUTHORIZATION TO CHARGE ANY FEE DEFICIENCY

- ☒ The Director is hereby authorized to charge any maintenance fee, surcharge or petition fee deficiency to Deposit Account No. 50-2691

7. OVERPAYMENT

As to any overpayment made, please

☒ Credit to Deposit Account No. 50-2691

OR

☐ Send refund check**WARNING:**

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

8. SHOWING

The enclosed statement will show that the delay in timely payment of the maintenance fee was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that this petition is being filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The statement must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which the patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

9. PETITIONER(S) REQUESTS THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED./Cary Tope-McKay/

Signature(s) of Petitioner(s)

October 27, 2010

Date

CARY TOPE-MCKAY

Typed or printed name(s)

41,350

Registration Number, if applicable

30765 Pacific Coast Highway #420

Address

310-589-8158

Telephone Number

Malibu, CA 90265

Address

ENCLOSURES:

- ☒ Maintenance Fee Payment
☒ Statement why maintenance fee was not paid timely
☒ Surcharge under 37 CFR 1.20(i)(1) (fee for filing the maintenance fee petition)
☐ Other:

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

/Cary Tope-McKay/

Signature

October 27, 2010

Date

CARY TOPE-MCKAY

Type or printed name

41,350

Registration Number, if applicable

STATEMENT

(In the space below, please provide the showing of unavoidable delay recited in paragraph 8 above.)

Included with this form is a Statement with a series of facts that collectively show that the delay was unavoidable.

(Please attach additional sheets if additional space is needed)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

NOV 08 2010

OFFICE OF PETITIONS

IN RE APPLICATION OF: NEIL STRATTON
APPLICATION No.: 09/801,536
PATENT NO: 6,793,224
FILED: MARCH 8, 2001
ISSUED: SEPTEMBER 21, 2004
TITLE: TRUCK FOR SKATEBOARDS

United States Patent and Trademark Office
Mail Stop: PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SHOWING (Item 8; Statement Showing Unavoidable Delay)

Dear Commissioner,

Below is a statement showing that the delay in timely payment of the 3-1/2 year maintenance fee for U.S. Patent No. 6,793,224 was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that this petition is being filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. More specifically, the following facts collectively show (1) evidence concerning the procedures in place that should have avoided the error resulting in the delay; (2) evidence concerning the training and experience of the persons responsible for the error; and (3) copies of any applicable docketing records to show that the error was in fact the cause of the delay. Thus, per MPEP §

711.03(c), subsection II.C.2, the facts set forth below collectively show that the delay in payment of the Maintenance Fee was "Unavoidable". The facts that collectively establish that the delay was Unavoidable, are as follows:

- Inventor and Petitioner, Neil Stratton, engaged patent counsel Christie, Parker & Hale LLP ("First Patent Counsel") to prepare and file a patent application directed to a Truck for Skateboards.
- On March 08, 2001, First Patent Counsel filed U.S. Patent Application No. 09/801,536 ("Patent Application").
- On August 01, 2002, First Patent Counsel instructed the USPTO to direct all correspondence, including fee-related correspondence, for the Patent Application, to the address of record for Customer Number 23363, which is Christie, Parker & Hale, 350 W. Colorado Blvd., Suite 500, Pasadena CA 91105. Attached hereto as Exhibit A is a copy of the instructions from First Patent Counsel.
- Sometime thereafter, a disagreement occurred between Petitioner and First Patent Counsel.
- On approximately August 15, 2002, First Patent Counsel filed a petition to withdraw as counsel and redirected ALL future correspondence, including fee-related correspondence, to the President of Carver Skateboards, Inc., Eyreick Williamson, at 245 Turnbull Canyon Dr., City of Industry, CA 91745. Attached hereto as Exhibit B is a copy of the application to withdraw as counsel and redirecting all future correspondence to Carver Skateboards, Inc. (Assignee at the time).
- In approximately November of 2002, Petitioner engaged the services of Tope-McKay & Associates ("Second Patent Counsel") to assist Petitioner, on a piece-meal basis, in responding to Office Actions and other communications from the USPTO.
- Due to Petitioner's experience with First Patent Counsel, Petitioner wanted to reduce docketing costs and maintain further control of the Patent Application. As such, although Petitioner engaged Second Patent Counsel to respond to USPTO communications related to the Patent Application, such communications continued to be mailed to Carver Skateboards, Inc., and Second Patent Counsel was not made the attorney of record on the USPTO's PAIR system.

- After responding to various communications from the Office, the Patent Application was allowed.
- On approximately April 14, 2003, the Petitioner prepared and mailed the Issue Fee Transmittal form to the USPTO. Attached herewith as Exhibit C is a copy of the Issue Fee Transmittal Form as prepared by Petitioner. It should be noted that in preparing the Issue Fee Transmittal Form, the Petitioner indicated that communications should continue to be directed to Eyreick Williamson, at 245 Turnbull Canyon Dr., City of Industry, CA 91745. Further, Petitioner believed that by entering Second Patent Counsel's name in Box 2 of the Issue Fee Transmittal Form, Second Patent Counsel would now become the listed Attorney of Record. However, as noted in the File Wrapper of the Patent Application, there is no attorney of record in the USPTO's PAIR system.
- The Patent Application issued as U.S. Patent No. 6,793,224 on September 21, 2004.
- Although Second Patent Counsel was not the attorney of record for managing the entire case (as Second Patent Counsel's services were engaged on a piece-meal basis), as a courtesy, Second Patent Counsel entered the issue date and maintenance fee payment due date into Second Patent Counsel's Docketing System. More specifically, Second Patent Counsel uses a redundant procedure for docketing. The redundant procedure includes use of both an Excel spreadsheet and Case Tracking Software (as produced by FlexTrac, Inc.), collectively referred to as the Docketing System.
- Patent issuance information was entered into the Docketing System and managed by staff of Second Patent Counsel, the staff being an attorney licensed by the State of California.
- During the time that the Maintenance Fee window was open (September 21, 2007 through March 22, 2008), Carver Skateboards, Inc. was managed by Eyreick Williamson, who was responsible for ensuring payment of the Maintenance Fees.
- On approximately February 29, 2008, review of the Docketing System notified Second Patent Counsel's Office Manager of the open Maintenance Fee window.
- On approximately February 29, 2008, Second Patent Counsel's Office Manager prepared and e-mailed a courtesy Maintenance Fee Reminder Letter to the Petitioner at neil.stratton@comcast.net, which was the e-mail address that was recorded in the Docketing System. Attached hereto as Exhibit D is a true and correct copy of the

Maintenance Fee Reminder Letter that was e-mailed to the Petitioner. Attached hereto as Exhibit E is a true and correct copy of the e-mail from the Second Patent Counsel's Office Manager to Petitioner regarding the Maintenance Fee Reminder Letter. As noted in Exhibit E, the e-mail was addressed to neil.stratton@comcast.net.

- The Petitioner's correct e-mail address was and is neilstratton@comcast.net, without the period separating his first and last name.
- Because the Docketing System had the wrong e-mail address, the Petitioner never received the courtesy Maintenance Fee Reminder Letter.
- Further, as noted in the Patent Bibliographic Data Sheet (attached herewith as Exhibit F), a Maintenance Fee Reminder was mailed by the USPTO to First Patent Counsel on March 31, 2008. Attached hereto as Exhibit G is a copy of the actual Maintenance Fee Reminder as mailed by the USPTO to First Patent Counsel. Thus, although First Patent Counsel directed the USPTO to change the correspondence address for all correspondence, the USPTO failed to change the fee address, which resulted in any fee reminders being mailed to First Patent Counsel and NEITHER Petitioner NOR Second Patent Counsel.
- First Patent Counsel DID NOT provide the Maintenance Fee Reminder to Petitioner.
- During the time that the Maintenance Fee window was open, the Petitioner was displeased with the management as provided by Eyreick Williamson and, in approximately August of 2008, the Petitioner removed Eyreick Williamson and took over Carver Skateboards, Inc.; however, Petitioner believed that the Maintenance Fee had been taken care of by previous management.
- The maintenance fee was not timely paid, which resulted in the patent expiring on September 21, 2008.
- On October 10, 2008, the USPTO mailed a Notice of Patent Expiration to the First Patent Counsel. Attached hereto as Exhibit H is a copy of the Notice of Patent Expiration as mailed to First Patent Counsel. Again, although First Patent Counsel directed the USPTO to change the correspondence address for all correspondence, the USPTO failed to change the fee address, which resulted in the Notice of Patent Expiration being mailed to First Patent Counsel and NEITHER Petitioner NOR Second Patent Counsel.

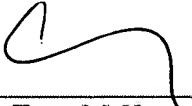
- The First Patent Counsel DID NOT provide the Notice of Patent Expiration to the Petitioner.
- Petitioner was in the process of preparing an assignment for the patent and contacted the USPTO in May of 2010 to inquire about assignment processes.
- Believing that the Patent was still valid, the Petitioner recorded an assignment with USPTO on June 21, 2010, as Reel/Frame (024563/0654). Attached hereto as Exhibit I is a copy of the Notice of Recordation.
- On October 19, 2010, Second Patent Counsel was in the process of preparing a letter on behalf of Petitioner, alleging infringement of the Patent by a competitor. In preparing the letter, Second Patent Counsel went to PAIR to copy a fresh set of claims from PAIR to incorporate into the letter. While on PAIR, Second Patent Counsel noticed that the status listed the patent as expired for failure to pay the maintenance fees. Second Patent Counsel immediately contacted Petitioner, who was shocked to hear that the Patent was expired.
- On October 20, 2010, Second Patent Counsel and Petitioner contacted the USPTO inventor assistance center (Reference Number 1-77297035) to inquire about the status of the case.
- On October 20, 2010, Second Patent Counsel ordered the complete file wrapper from Thomson Reuters (Order Number: 1058551) to review the file wrapper and identify how the delay in payment of the maintenance fee occurred. Attached hereto as Exhibit J is a copy of the Order Confirmation from Thomson Reuters.
- On October 21, 2010, counsel received the file wrapper from Thomson Reuters and began gathering exhibits and preparing the present Petition to Revive based unavoidably delayed payment.

///

///

///

We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity any patent issued thereon.


Cary Tope-McKay


Neil Stratton

10/27/2010
Date

10-27-2010
Date